

REMARKS

The Office Action mailed November 21, 2005, has been received and reviewed. Claims 12, 15-18 and 22-24 are currently pending in the application. Claims 12, 15-18 and 22-24 stand rejected. Claims 12, 18 and 22 are amended herein. Claims 1-11, 13, 14, 19-21, 25 and 26 are withdrawn from consideration. Claims 15-17 are cancelled herein. Claims 27 and 28 are added herein. Amendments and cancellations have been made without prejudice or disclaimer. No new matter has been added.

More particularly, support for added claims 27 and 28 may be found, *inter alia*, in paragraph [0041] of the as filed specification.

Reconsideration of the application is respectfully requested.

Information Disclosure Statement

The Office asserts that the information disclosure statement (IDS) filed January 18, 2005 fails to comply with 37 C.F.R. 1.98(a)(3) because it does not include a concise explanation of the relevance of each patent listed that is not in the English language, more particularly foreign patent DE 19735902.

In order to satisfy the requirements of 37 C.F.R. 1.98(a)(3), applicant submits herewith a supplemental IDS with the abstract in English of the German patent DE 19735902. Applicant kindly requests acknowledgement of consideration of the IDS filed on January 18, 2005, along with the currently submitted IDS with the English translation of the abstract of foreign patent DE 19735902.

It is respectfully submitted that, because the applicant did not have possession of the English translation of the abstract of foreign patent DE 19735902, it is not necessary to pay the fee associated with the supplemental IDS submitted herewith. However, if the fee is deemed necessary, please bill our Deposit Account No. 20-1469.

Specification

The abstract of the disclosure is objected to because it is allegedly more than one paragraph in length.

Applicant has amended the abstract herein according to the Examiner's suggestions.

As such, applicant requests withdrawal of the objection to the abstract.

Claim Objections

Claim 17 is objected to for missing a “.” at the end of the claim. Claim 17 has been cancelled, thus mooting the rejection of this claim.

Claim Rejections—35 U.S.C. § 112, first paragraph, written description

Claims 12, 15-18, and 22-24 are rejected under 35 U.S.C. § 112, first paragraph, as allegedly containing subject matter that was not described in the specification in such a way as to reasonably convey to one of skill in the art that the inventors has possession of the claimed invention at the time of filing. Claims 15-17 have been cancelled herein, thus mooting the rejection of these claims. Applicant traverses the remainder of the rejection.

Possession of the claimed invention may be shown by describing the elements of the claimed invention by using descriptive words, structures, figures, diagrams and formulas. *Lockwood v. Am. Airlines, Inc.*, 107 F.3d 1565, 1572, 19 USPQ2d 1961, 1966 (Fed. Cir. 1997). Applicant respectfully submits that the elements of the claimed invention are described in such descriptive terms as to reasonably convey to one of skill in the art that the inventor had possession of the invention at the time of filing.

Amended independent claims 12 and 22 recite, in part, a β -sheet breaker peptide analog which is generated by chemical modification of a β -sheet breaker peptide consisting of SEQ ID NO: 1. It is respectfully submitted that the amended claims 12 and 22 meet the written description provision of 35 U.S.C. § 112, first paragraph.

More particularly, paragraph [0033] of the specification as filed describes altering the N- or C-terminal end of SEQ ID NO: 1. Paragraph [0034] illustrates replacement of SEQ ID NO: 1 with α -aminoisobutyric acid (Aib). Paragraphs [0034] through [0035] explain modification of an α carbon of SEQ ID NO: 1 selected from the group consisting of methylation, alkylation and dehydrogenation. Paragraph [0036] describes chirality changes made to SEQ ID NO: 1 by replacement of an L-enantiomeric residue with a D-enantiomeric residue. Paragraph [0037] outlines head-to-tail cyclization of SEQ ID NO: 1 and paragraphs [0038] through [0043] detail replacement of amide bonds in SEQ ID NO: 1 with amide bond surrogates.

In regard to claim 18, written description is provided, *inter alia*, by paragraph [0033] in the specification as filed. The description of claims 23 and 24 is provided, *inter alia*, by TABLE 1.

Furthermore, the examples in paragraph [0041] and [0058] through [0063] of the as-filed specification provide the specific activity of a β -sheet breaker peptide analog consisting of SEQ ID NO: 1.

As such, applicant affirms that the specification describes the elements of claims 12, 18, and 22-24 with such detail to convey to one of skill in the art that the inventor had possession of the claimed invention at the time of filing.

It is respectfully requested that the rejection of claims 12, 18, and 22-24 be withdrawn.

Claim Rejections—35 U.S.C. § 112, second paragraph

Claims 12 and 15-18 are rejected under 35 U.S.C. § 112, second paragraph, as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as his invention. Claims 15-17 have been cancelled herein, thus mooting the rejection of these claims. Applicant traverses the remaining rejection for the following reasons.

The Office asserts that claims 12 and 18 are indefinite because it is unclear of the meaning of the term “capable of” and “designed by” in claim 12.

While the applicant does not agree with the alleged indefiniteness, claim 12 has been amended according to the Examiner’s suggestions.

Accordingly, it is respectfully requested that the rejections of claims 12 and 18 be removed.

Double patenting rejection

Claim 22 is rejected under the judicially created doctrine of obviousness-type double patenting as allegedly being unpatentable over claims 1 and 8 of U.S. Patent 5,948,763 (hereinafter the ‘763 patent). Applicant respectfully submits that amended claim 22 is allowable over claims 1 and 8 of the ‘763 patent.

A double patenting rejection of the obviousness-type is analogous to a failure to meet the nonobviousness requirement of 35 U.S.C. 103 except that the patent principally underlying the

double patenting rejection is not considered prior art. *In re Braithwaite*, 379 F.2d 594, 154 USPQ 29 (CCPA 1967). Therefore, any analysis employed in an obviousness-type double patenting rejection parallels the guidelines for analysis of a 35 U.S.C. § 103 obviousness determination. *In re Braat*, 937 F.2d 589, 19 USPQ2d 1289 (Fed. Cir. 1991); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985). M.P.E.P. § 804.

First, applicant notes that the cited '763 patent and the above-referenced application were never co-pending and, as such, an obviousness-type double patenting rejection would appear to be improper.

Furthermore, to establish and maintain a *prima facie* case of obviousness under 35 U.S.C. § 103, M.P.E.P. § 706.02(j) states that the prior art reference must teach or suggest all the claim elements.

Amended independent 22 recites, in part, a β -sheet breaker peptide analog which is generated by chemical modification of a β -sheet breaker peptide consisting of SEQ ID NO: 1.

Claims 1 and 8 of U.S. Patent 5,948,763 do not teach or suggest all the elements of amended claim 22.

Accordingly, a *prima facie* case of obviousness cannot be established for claim 22 and, as such, applicant requests removal of this obviousness-type double patenting rejection and request reconsideration of the claims.

Claim rejections—35 U.S.C. § 102(b)

Claims 12, 17-18, and 22-24 are rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by Findeis *et al.* (WO 96/28471) (hereinafter “Findeis”). Claim 17 has been cancelled herein, thus mooting the rejection of this claim. Applicant respectfully traverses the remaining rejection because Findeis does not disclose each and every element of amended independent claims 12 and 22.

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single reference which qualifies as prior art under 35 U.S.C. § 102. *Verdegaal Brothers v. Union Oil Co. of California*, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). Likewise, the identical invention must be shown in as complete detail as is contained in the claim. *Richardson v. Suzuki Motor Co.*, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

Amended independent claims 12 and 22 recite, in part, a β -sheet breaker peptide analog which is generated by chemical modification of a β -sheet breaker peptide consisting of SEQ ID NO: 1.

Findeis does not disclose a β -sheet breaker peptide analog which is generated by chemical modification of a β -sheet breaker peptide consisting of SEQ ID NO: 1.

It is, therefore, respectfully submitted that, under 35 U.S.C. § 102(b), amended independent claims 12 and 22 recite subject matter which is not anticipated by Findeis.

Furthermore, claims 18, 23 and 24 are each not anticipated, among other reasons, for depending either directly or indirectly from claims 12 or 22 which are not anticipated.

For these reasons, withdrawal of the 35 U.S.C. § 102(b) rejections of claims 12, 18 and 22-24 is respectfully solicited.

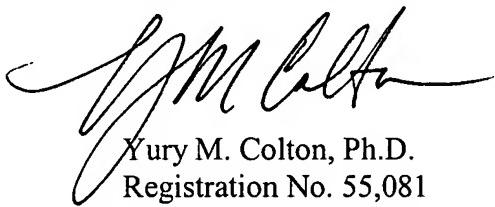
Claim rejections—35 U.S.C. § 103(a)

The rejection of claims 15-16 under 35 U.S.C. § 103(a) as allegedly being unpatentable over Findeis as applied to claims 12, 17-18 and 22-24 above and further in view of Soto *et al.* (Nat Med 4(7):822-826, July 1998) is rendered moot by the cancellation of claims 15-16 herein.

CONCLUSION

In view of the foregoing amendments and remarks, the applicant submits that the claims define patentable subject matter and a notice of allowance is requested. Should questions exist after consideration of the foregoing, the Office is kindly requested to contact the applicant's attorney at the address or telephone number given herein.

Respectfully submitted,



Yury M. Colton, Ph.D.
Registration No. 55,081
Attorney for Applicant
TRASKBRITT
P.O. Box 2550
Salt Lake City, Utah 84110-2550
Telephone: 801-532-1922

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Enclosure: Supplemental IDS with English Language Abstract of Foreign Patent